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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,177	01/21/2004	Loretta E. Allen	84196DF-P	4773

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,177

Applicant(s)

ALLEN ET AL.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of the amendment, on 2/28/2005, which has been entered in the file. It is acknowledged that this application is a divisional of application serial number 10/310,519. The parent application has been reviewed, and it is noted that a restriction requirement was made in the parent application, thus precluding a double patenting rejection over related application serial numbers 10/761,671 and 10/762,169. Claims 1-3 are pending.

#### ***Specification***

1. The abstract of the disclosure is objected to because the abstract contains the legal terminology "said" in lines 3 and 4. Correction is required. See MPEP § 608.01(b).

#### ***Claim Objections***

2. Claim 2 is objected to because of the following informalities: Claim 2, line 16: "coated" should be replaced with --encoded--, in order to provided proper antecedent basis for "said encoded information" as recited in line 17. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale (US 5,990,918, previously cited) in view of Gregory et al (US 5,160,171).

Baxendale teaches a computer program product, a method of reading a media, and a method for providing indicia on a media, comprising the steps of: forming a first machine-readable indicia (an image on receiving layer 4, for example, see column 2 lines 15-17 and column 3 lines 39-41) in an image layer (receiving layer 4) on a media (an identity card or bank/credit card, for example); forming a second machine-readable indicia (a relief image, formed by pixels 7' or regions 10) in a protective overlayer (clear plastics material 7), said protective overlayer being substantially transparent so as to allow said first machine-readable indicia to be read through said protective overlayer (see column 2 lines 15-17, column 3 lines 10 and 39-41); reading the physical topography of said second machine-readable indicia on said overlayer by a machine (in an automated authentication process, for example) so as to obtain information (the authenticity information) encoded therein; interpreting said encoded information so as to obtain said encoded information (see figures 1, 3, 4, column 1 line 58 - column 2 line 3, column 2 lines 7-43, and column 3 lines 8-40).

Baxendale fails to specifically teach the second machine-readable indicia being identical in content to and in register with said first machine readable indicia.

Gregory et al teaches a computer program, a method of reading a media, and a method for providing indicia on a media, comprising: forming a first machine-readable indicia (a coded i-r mark) on a media; forming a second machine-readable indicia (a coded colour mark) overlaying the first machine-readable indicia (the coded colour mark

overlays the i-r mark), the second machine-readable indicia being identical in content to and in register with said first machine-readable indicia (Gregory et al teaches that the colour mark is overlaps the i-r mark, see column 3 lines 1-15, thus suggesting the colour mark is identical in content and in register with the i-r mark); reading the first and second machine-readable indicia by a machine (see column 2 line 37 - column 3 line 18).

In view of Gregory et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the teachings of Baxendale, the second machine-readable indicia being identical in content to and in register with said first machine readable indicia, in order to provide an additional, hidden, authentication feature, thereby further improving security.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection. As discussed above, Baxendale teaches a media having first and second machine readable indicia (the images as taught by Baxendale are considered machine readable in that the images can be recognized using common scanning, image capture, or character recognition techniques). Gregory et al suggest providing first and second machine readable indicia, identical in content to, and in register with each other, so as to include hidden authentication features on a media.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Swan (US 4,823,373) teaches an overlay, containing indicia, designed to be placed over a media containing at least some of the same indicia. Frey (US 6,622,878) teaches a label, including indicia, designed to be placed over identical indicia.


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jared J. Fureman  
Examiner  
Art Unit 2876

May 15, 2005